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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/800,483	03/08/2001	Akihiro Murata	108883	4961
25944	7590	04/15/2004	EXAMINER	
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			NASRI, JAVAID H	
			ART UNIT	PAPER NUMBER
			2839	

DATE MAILED: 04/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/800,483	Applicant(s) MURATA, AKIHIRO	
	Examiner Javaid Nasri	Art Unit 2839	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2003.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26,28-33,35 and 36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-19 is/are allowed.
- 6) ☒ Claim(s) 20-26,28-33,35 and 36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 March 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the

- a) recess formed in the interconnecting line per claim 23,
- b) a resin having light transmitting properties per claims 18 and 29,

must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the

Art Unit: 2839

reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 20, 21, 23, 25, 26 and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by Yoshida et al (6,632,027).

Yoshida et al discloses a resin molded component (150) formed of resin; an interconnecting line (147, also see marked figure 1, attached) in the molded component, at least part of the interconnecting line being exposed; and a through hole in which an optical fiber (130) is inserted is formed in the molded component, an indent for receiving an optical element (110) is formed in the molded component, a recess (see marked figure 1, attached) is formed in the interconnecting line so that a bottom surface of the recess is exposed from the molded component, an electronic component (121) is incorporated in the molded component and is electrically connected the interconnecting line, a resin to seal the optical element (see figure 2).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 30-33 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshida et al. in view of Torazawa (6,177,689).

Art Unit: 2839

Yoshida et al discloses all the limitations of claim 20, as shown above, Yoshida et al also discloses a semiconductor chip (120), resin seal (see figure 2), a plug connected to the optical element (see figure 1).

However, Yoshida et al does not disclose:

- a) a plurality of platforms. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a plurality of platforms since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.
- b) Light transmitting resin. Torazawa discloses light transmitting resin. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention for Yoshida et al or Iwase et al to have light transmitting resin in view of Torazawa to eliminate loss of light.

6. Claims 20-26, 28 and 35 are rejected under 35 U.S.C. 102(e) as being anticipated by Iwase et al (6,270,263).

Iwase et al discloses a resin molded component (see figure 6) formed of resin; an interconnecting line (2) in the molded component, at least part of the interconnecting line being exposed; and a through hole in which an optical fiber (9, Of) is inserted is formed in the molded component, an indent for receiving an optical element (for example 4) is formed in the molded component, a recess (7g, 35g) is formed in the interconnecting line so that a bottom surface of the recess is exposed from the molded component, an electronic component (5) is incorporated in the molded component and is electrically connected the interconnecting line, a resin to seal the optical

Art Unit: 2839

element (see figure 6), stepped form (8b), the recess (35g) formed in the interconnecting line is filled with a conductive material (31), semiconductor chip (5).

7. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshida et al or Iwase et al in view of Torazawa (6,177,689).

Yoshida et al or Iwase et al discloses all the limitations of claims 20, 26 and 28 as shown above,

However, Yoshida et al or Iwase et al does not disclose:

a) Light transmitting resin. Torazawa discloses light transmitting resin.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention for Yoshida et al or Iwase et al to have light transmitting resin in view of Torazawa to eliminate loss of light.

#### *Allowable Subject Matter*

8. Claims 1-19 are allowed.

#### **REASONS FOR ALLOWANCE**

9. The following is an examiner's statement of reasons for allowance:

The reason for allowance of the claims is the inclusion of the limitation,

a) for claim 1, none of the prior art teaches or suggest, alone or in combination the steps of the method as claimed, in combination with other limitations in the claim which is not found in the prior art reference of record.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue

Art Unit: 2839

fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### *Contact*

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Javaid Nasri whose telephone number is 571 272 2095. The examiner can normally be reached on Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynn Feild can be reached on 571 272 2800 ext 39. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**Any correspondence to this action may be mailed to:**

**Commissioner for Patents  
Post Office Box 1450  
Alexandria, VA 22313-1450**

For additional information regarding this new address, which was effective May 1, 2003, see *Correspondence with the United States Patent and Trademark Office*, 68 Fed. Reg. 14332 (March 25, 2003).

Art Unit: 2839

**Or faxed to:** 703-308-7722 or 308-7724 (informal or draft communications should be clearly labeled

“PROPOSED” or “DRAFT”)

**Hand-delivered responses should be brought to:**

**Crystal Plaza 4, Fourth Floor (receptionist)**

**2201 South Clark Place, Arlington, Virginia**



Javaid Nasri  
Primary Examiner  
Art Unit 2839

JN

jhn

April 9, 2004